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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,376	05/02/2001	Dennis Mendiola	8098.0010	3928
22852	7590	08/23/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005				COFFY, EMMANUEL
ART UNIT		PAPER NUMBER		
2157				

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/846,376	MENDIOLA ET AL. 
	Examiner Emmanuel Coffy	Art Unit 2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 May 2001.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-8 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-8 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 02 May 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is responsive to the application filed on 2 May, 2001. Claims 1-7 are pending. Claims 1-7 are directed to a "Method and System for Tracking the Online Status of Active Users of an Internet-Based Instant Messaging System."

**Specification**

2. The disclosure does not include a "Summary" Section and "Detailed Description of the Invention" as required. See MPEP § 608.01(d) and (g). Appropriate correction is required.

3. The abstract in an application filed under 35 USC §111 may not exceed 150 words in length. See MPEP § 608.01(b). Appropriate correction is required.

**Priority**

4. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in PCT on 5/11/2000. It is noted, however, that applicant has not filed a certified copy of the PCT application as required by 35 U.S.C. 119(b).

**Drawings**

5. The informal drawings are not of sufficient quality to permit examination. Accordingly, replacement drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to this Office action. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

Applicant is given a TWO MONTH time period to submit new drawings in compliance with 37 CFR 1.81. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely submit replacement drawing sheets will result in **ABANDONMENT** of the application. Additionally, the numbers in the flow charts must be replaced with text.

### **Claim Objections**

6. Each claim must be the object of a sentence starting with "I claim" or "We claim". See MPEP § 608.01(m). In this case the language: "The claims defining the invention are as follows" is objected to. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

#### ***Claims 3, 7-8 are rejected.***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 3 is rejected under 35 U.S.C. §112 ¶2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention due to ambiguous language from direct translation. A reasonable artisan skilled in the art could not comprehend the claims as written. The claim recites: "(iv) other activities..." other activities is undefined within the claim language. It is not clear what the boundary of the claim is. Hence, the scope of the claim is unascertainable.

However, in order to expedite a more complete examination the Examiner asserts that this invention is understood as: "sign on activities."

8. Claim 7 and 8 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claimed limitation of "substantially as herein described with reference to the accompanying drawings as appropriate." is vague, unclear, and ambiguous. However, to expedite a complete examination of the instant application claims 7 and 8 are understood as not incorporating said amorphous language in its entirety.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-7 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wick (US 6,691,162) in view of Appleman et al. (US 6,539,421). and in further view of Carey et al. (US 6,714,793.)

Wick substantially teaches the invention as claimed including communicating with and/or monitoring of a targeted used in computer-network environment (e.g. an instant messaging system) involves detecting that the targeted user has signed on to the network, and upon detecting the signon, automatically communicating with the targeted user. (See abstract).

Claim 1:

Referring to claim 1 Wick substantially teaches a system for establishing or specifying the online status of a user forming part of an instant messaging system comprising a plurality of clients having IM client applications of the same or different types and an IM server selectively connected to each of said clients via a computer network, the system comprising: (See col. 2 line 63 through col. 4, line 40).

a user database for storing an activity status for each user of the IM system with respect to the IM server, said activity status including: (i) a time variable signifying the time of or time since the last prescribed involvement of the user with said IM server; and (ii) a probability variable signifying the likelihood of the user still being online; (See col. 4, lines 19-25).

monitoring means to continuously monitor user activity with said IM server and to continuously update the activity status of users stored on said database involved with said activity; and (See col. 4, lines 10-18).

checking means to check the activity status of each user stored on said database and adjust said probability variable in a prescribed manner having regard to said time variable. (See col. 2, lines 63-col. 3, line 1).

Wick teaches a computer-implemented method of communicating with a user includes detecting that a previously unavailable user is available to receive messages. Wick does not explicitly suggest; however, Appelman teaches a method of keeping track of the last involvement of the user with the server with a time stamping field at col. 9, lines 36-56). Hence, it would have been obvious at the time of the invention for an

artisan of ordinary skill in the art to combine the teachings of Wick with message time stamping as disclosed by Appleman. In the context of "instant messaging" knowing the time a message was sent is critical, because knowing when (time) a user is online is an important parameter of the system.

Neither Wick nor Appleman expressly teaches a database for storing an activity of the user; however, Carey teaches such concept at col. 3, lines 20-34). Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the teachings of Wick with message time stamping as disclosed by Appleman with the database as disclosed by Carey. The need exists to provide the benefits of instant messaging, immediate knowledge of another on-line status and real-time text communication, outside of hard-wired Internet systems. Specifically, in a wireless environment, it would be advantageous to know if a subscriber has turned on their cellular phone and to communicate via text, which is far less expensive rather than voice. Therefore, claim 1 is rejected.

Claim 2:

Referring to claim 2 Wick substantially teaches a system as claimed in claim 1, wherein said client types include clients connected to the computer network via:

- (i) a PC-based instant messaging client application program; (See Fig. 1)
- (ii) a GSM device on a GSM network;
- (iii) an internet browser-based client application; or (See Fig. 2)
- (iv) an email-based client application. (See Fig. 2 and col. 2, lines 17-20).

Wick expressly teaches (i), (iii) and (iv), however Wick fails to teach a GSM network. However, Carey prominently discloses GSM at col. 3 lines 53-57. Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the teachings of Wick with a GSM network as disclosed by Carey. GSM is the global system for mobile communications and it is the primary digital wireless standard used throughout Europe. Therefore, claim 2 is rejected.

Claim 3:

Referring to claim 3 Wick substantially teaches a system as claimed in claim 1 wherein said prescribed involvement with said IM server includes:

- (i) one client sending a message to another; (See col. 5, lines 7-22).
- (ii) one client successfully receiving a message sent from another; (See col. 5, lines 40-64).
- (iii) one checking the activity status of another user(s); and (See col. 4, lines 6-18).
- (iv) sign on activities, involving the IM server system that can be detected by computer and electronic methods. (See col. 5, lines 34-39).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to use the teachings of Wick. Therefore, claim 3 is rejected.

Claim 4:

Referring to claim 4 Wick substantially teaches a system as claimed in claim 1, wherein said computer network is the internet and/or any direct electronic link. (See Fig.

2). Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to use the teachings of Wick. Therefore, claim 4 is rejected.

Claim 5:

Referring to claim 5 Wick substantially teaches a system as claimed in claim 1, wherein said client types connected to the computer network via the GSM network have SMS capability and are initially connected to the computer network via an SMSC server to control and manage said SMS therebetween, said SMSC server and said IM server being directly interconnected via said computer network, and wherein said SMSC server provides an indication to said monitoring means of the activity of targeted recipient GSM clients in response to messages sent to the SMSC server for delivery thereto by said IM server.

Wick extensively teaches the concept of IM throughout (See col. 1, lines 63-67). Wick does not expressly disclose the computer network connected via GSM with SMSC capability. However, Carey specifically teaches connection via a GSM network with SMSC capability at col. 3, lines 22-58). Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the teachings of Instant Messaging (IM) Wick with connection via a GSM network as disclosed by Carey. In a wireless environment, it would be advantageous to know if a subscriber has turned on their cellular phone and to communicate via text, which is far less expensive rather than voice. Therefore, claim 5 is rejected.

Claim 6:

Referring to claim 5 Wick substantially teaches a method for establishing or specifying the online status of a user forming part of an instant messaging system comprising a plurality of clients having IM applications of the same or different types, selectively interconnected to an IM server by way of a computer network, the method comprising the following steps: (See col. 2, line 63-col. 3, line12).

storing an activity status for each user of the IM system with respect to the IM server, said activity status including: (i) a time variable signifying the time of or time since the last prescribed involvement of the user with said IM server; and (ii) a probability variable signifying the likelihood of the user still being online; (See col. 4, lines 19-25).

continuously monitoring user activity with said IM server continuously updating the stored activity status of users involved with said activity; (See col. 3, lines 46-56; See col. 5, lines 34-39, col. 6, lines 44-53).

checking the stored activity status of each user; and  
adjusting said probability variable in a prescribed manner having regard to said time variable. (See col. 3, lines 46-56)

Wick teaches a computer-implemented method of communicating with a user includes detecting that a previously unavailable user is available to receive messages. Wick does not explicitly suggest; however, Appelman teaches a method of keeping track of the last involvement of the user with the server with a time stamping field at col. 9, lines 36-56). Hence, it would have been obvious at the time of the invention for an

artisan of ordinary skill in the art to combine the teachings of Wick with message time stamping as disclosed by Appleman. In the context of "instant messaging" knowing the time a message was sent is critical, because knowing when (time) a user is online is an important parameter of the system.

Neither Wick nor Appleman expressly teaches a database for storing an activity of the user; however, Carey teaches such concept at col. 3, lines 20-34). Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the teachings of Wick with message time stamping as disclosed by Appleman with the database as disclosed by Carey. The need exists to provide the benefits of instant messaging, immediate knowledge of another on-line status and real-time text communication, outside of hard-wired Internet systems. Specifically, in a wireless environment, it would be advantageous to know if a subscriber has turned on their cellular phone and to communicate via text, which is far less expensive rather than voice. Therefore, claim 6 is rejected.

Claims 7 and 8:

Referring to claims 7 and 8, they do not teach or define any significantly new limitations above and beyond claims 1-6 to warrant particular treatment, and therefore are rejected for similar reasons.

### Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Alanara et al. (U.S. 6,292,668) teaches "Communication Network Terminal Supporting a Plurality of Applications."

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Coffy whose telephone number is (703) 305-0325. The examiner can normally be reached on 8:30 - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Emmanuel Coffy  
Patent Examiner  
Art Unit 2157

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EC  
Aug 12, 200423



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